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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,058	12/07/2001	David Reginald Adams	20791	7827

151 7590 03/11/2003

HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
340 KINGSLAND STREET
NUTLEY, NJ 07110

EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,058

Applicant(s)

ADAMS et al.

Examiner

Emily Bernhardt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-35,38,41-42, drawn to compounds, simple compositions and uses and process of making ^{where A2 = aryl, cycloalkyl & substituted derivatives}, classified in class 544, subclass 389; class 514, subclass 255.01. FB
3/30/03
- II. Claims 1-9, 12-13,33-35,38 and 41-42, drawn to compounds, simple compositions and uses and process of making ^{where A2 = heteroaryl & substituted derivatives}, classified in class 544, subclasses such as 357,360, 379 and others as determined by the nature of A2 ring described; class 514, subclasses such as 252.11, 253.01, etc. FB
3/30/03
- III. Claims 36-37,39-40,43-44, drawn to complex compositions and uses employing such containing compounds of I and a lipase inhibitor, classified in class 514, subclasses various as determined by the exact nature of active ingredients employed.
- IV. Claims 36-37, 39-40,43-44, drawn to complex compositions and uses employing such containing compounds of II and a lipase inhibitor, classified in class 514, subclasses various as determined by the exact nature of active ingredients employed.

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In addition to an election of one of the above groups applicants must also elect a single species embrative of elected group to which claim(s) may be limited should generic claims be found not allowable. If III or IV is picked an ultimate pair of species comprising the active ingredients must also be elected.

The inventions are distinct, each from the other because of the following reasons: Compounds within I and II are drawn to structurally dissimilar compounds in view of the varying choices permitted throughout the variables especially at A2 . Thus they are separately classified, and may raise different issues of patentability in view of the structural dissimilarity for compounds of I vs II as a whole. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group.

Compounds in I/II may be old or obvious when separately employed but may be patentable due to superior, or synergistic properties not present for the individual components in III/IV. Within groups III and IV there are more than one invention as the claims embrace multiple combinations which require independent searches and which are not art-recognized equivalents in the art.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.


EMILY BERNHARDT

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PRIMARY EXAMINER

GROUP 1600